

REMARKS:

ELECTION OF SPECIES

In response to the election of Species requirement contained in the Office Action of November 29, 2004, Applicants hereby provisionally elect Species B (FIGS. 2-5), Claims 1-6 and 8-24 for further prosecution on the merits with the understanding that upon the allowance of a generic claim, the Applicants will be entitled to consideration of those claims to additional species written in dependent form or which otherwise include all the limitations of the base claim(s).

CLAIM AMENDMENTS

Applicants have amended claim 1 to place it in a more appropriate "means plus function" format. With regard to the amendments of claims 2-14, Applicants have amended such claims to place them in better grammatical format and to render them more consistent with one another.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nishiyama *et al.* (US 4226308) in view of JP 59-47531 (Yangai) or JP 62-242142 to Hattori *et al.*

Applicants request that the Examiner reconsider and withdraw the above rejection of the claims in view of the following:¹

¹ A determination under 35 U.S.C. §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ 2d 1451, 1453 (Fed. Cir. 1997). An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), see also *Robotic Vision Sys., Inc. v. View Eng'g Inc.*, 189 F.3d 1370, 1376, 51 USPQ 2d 1948, 1953 (Fed. Cir. 1999).

In line with this standard, case law provides that "the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the invention] should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988). The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48

In the present case, the examiner has not met the burden to establish a *prima facie* case of obviousness. More specifically, there is no teaching, suggestion or motivation contained in any of the references cited by the Examiner to combine their individual teachings to create the inventions of independent claims 1 and 15, or the inventions recited in those claims depending therefrom. The examiner also has not shown, by reference to objective concrete evidence, that the teaching, suggestion or motivation to combine the reference teachings emanates from that knowledge generally available to one having ordinary skill in the art.

First, each of claims 1 and 15 include the limitations that the brake disk cover be partially formed from a temperature reactive material that, when a certain temperature is reached, assumes an open position to thereby allow cooling air to directly strike the brake disk of the disk brakes. While Nishiyama discloses disk brake assemblies and covers therefor, Nishiyama does not disclose, teach or suggest temperature reactive materials. On the contrary, largely owing to the fact that it is specifically designed for use with motorcycles, which allow ready access to the disk brake assemblies, Nishiyama discloses a "fan type" or "nesting" type disc cover that is manually opened and closed based on environmental conditions, by means of a fixing pin; "...the fixing pin locks the elements together in a stored position as shown in FIG. 6...[w]hen the cover units are to be deployed, the fixing pins removed and the elements are spread..." (see col. 2, lines 26-70). Nishiyama does not disclose, teach or suggest automatic opening and closing of a disc cover by means of a temperature reactive material.

USPQ 2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617. The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988); see also *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

The examiner has the burden of establishing a *prima facie* case of obviousness. *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995). The burden to rebut a rejection of obviousness does not arise until a *prima facie* case has been established. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993). Only if the burden of establishing a *prima facie* case is met does the burden of coming forward with rebuttal argument or evidence shift to the applicant. *In re Deuel*, 51 F.3d 1552, 1553, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995), see also *Ex parte Obukowicz*, 27 USPQ 2d 1063, 1065 (B.P.A.I. 1992).

Second, each of independent claims 1 and 15 also include the limitation that the cooling air directly strike the brake disk. Yanagi and Hattori relate to drum brake assemblies, which do not comprise brake disks. Consequently, Yanagi and Hattori relate to completely different braking type systems such that it is more likely than not that one having ordinary skill in the art would not even have had the references before them for consideration/combination, much less combine them as Applicants have claimed. Additionally, based on the Applicants' understanding of the references in view of the Abstracts and drawings, each of Yanagi and Hattori disclose cooling openings that are disposed on the planar circumferential faces of the drum brake assemblies. As a result, cooling air is not caused to directly strike the brake disks as required by claims 1 and 15. Finally, based on the Applicants' understanding of Yanagi and Hattori in view of the Abstracts and drawings, each of Yanagi and Hattori are silent with regard to disk brake systems and brake disks, therefore it is respectfully asserted that there is no teaching, suggestion or motivation to combine the references as propounded by the examiner to create the inventions of claims 1 and 15.

In sum, Nishiyami discloses a manually operated “nesting” type cover for a disk brake for a motorcycle and Yanagi and Hattori each relate to cover systems for drum brakes that do not even have brake disks or allow cooling air to directly strike the brake disks. There is simply no teaching, suggestion or motivation contained in the references cited by the examiner to combine/modify the reference teachings to create the invention of claims 1 and 15. Based on the above, then, Applicants respectively submit that examiner's motivation to select and combine the reference teachings to render the invention of claims 1 and 15 obvious emanates not from the teachings of the references themselves, but from an impermissible application of hindsight reconstruction to thereby use that which the inventor taught against its teacher.

In view of the above, Applicant submits that the requirement and burden of presenting a *prima facie* case of obviousness under 35 USC §103 has not been presented. Therefore Applicant requests the reconsideration and withdrawal of the rejection of Claims 1 and 15, and those depending therefrom, under 35 USC §103 and that the Examiner indicate the allowance of the claims in the next paper from the Office.

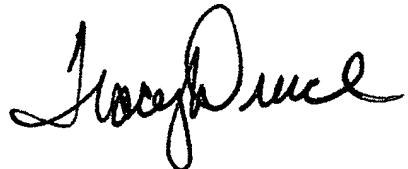
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Applicant: SABELSTRÖM, Mats *et al.*
Atty. Ref.: 7589.187.PCUS00

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, Order No. 7589.187.PCUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,



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